

Philip E. EGGERS et al.
Application No.: 10/627,313
Page 5

Docket No. A-3-4

REMARKS

RECEIVED
CENTRAL FAX CENTER

NOV 28 2006

General Comments

Claims 54-70 are pending in the subject application.

Rejections of Claims under 35 U.S.C. §102(b)

According to the Office Action, claims 54-59, 65-70 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,103,804 to Abele et al. ("Abele"). Applicant respectively disagrees.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 *citing* Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

Abele does not disclose at least one element in the pending claims. In particular, Abele does not disclose an active electrode having a hemispherical shape or geometry. A hemispherical geometry is "half a sphere or half the earth" *The Oxford Color Dictionary & Thesaurus*, Oxford University Press (1996). By no stretch of the imagination does Abele disclose such an active electrode.

Abele discloses "[a]nnular electrical contacts 22 and 24 inside a balloon ..." Col. 4, lines 17-18. The electrical contacts disclosed in Abele are essentially rings. See, for example, FIG. 1. The dictionary also supports this distinction. The dictionary defines annular as "ring-shaped". *The Oxford Color Dictionary & Thesaurus*, Oxford University Press (1996). Although both annular and hemisphere have some degree of curves, the two geometrical shapes are different. A ring is not half of a sphere just as an annular electrode is not a hemispherical electrode. Consequently, Abele does not disclose a hemispherical electrode and does not anticipate any of the pending claims. Reconsideration and withdrawal of the rejection is requested.

Philip E. EGGERS et al.
Application No.: 10/627,313
Page 6

Docket No. A-3-4

Claims 54-70 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,532,924 to Auth et al. ("Auth").

Applicant has amended the independent claims to recite that the return electrode is substantially larger than the electrode terminal. Auth does not disclose this claim limitation. Auth is directed to a plurality of uniformly distributed opposite electrode pairs or poles. The electrodes have similar size or equal size. This is therefore different than the that recited by the present claims.

Based on the foregoing, Applicant respectfully requests reconsideration of the rejection of claims 54-70 based on Auth.

Applicant has made a sincere effort to respond to each and every issue raised in the Office Action. Should the Examiner wish to contact the Applicant he is encouraged to do so at the below referenced number.

Respectfully submitted,



Rick Batt
Reg. No. 43,485

ArthroCare Corporation
680 Vaqueros Avenue
Sunnyvale, California 94085-3523
Direct Phone: 408/735-6323